REMARKS/ARGUMENTS

Status:

This After Final Amendment is provided in response to the Office Action mailed February 27, 2009. In that Office Action claims 1 -23 are indicated as pending, wherein:

- Claims 1, 5-7, 9-16, and 19-23 are rejected as being obvious over Carles in view of Flickinger, and further in view of Del Sesto (the combination is referred to hereafter as "CFD");

- Claims 2-4 are rejected as obvious in light of CFD in view of Hall;

- Claim 8 is rejected as obvious in view of CFD in view of Bergman; and

- Claims 17 and 18 are rejected in view of CDF in view of Chen.

Claim Amendments

Applicant has amended claim 22 to provide for the proper antecedent basis. Applicant submits that no further searching is necessitated by such amendment.

DISCUSSION

Applicant respectfully requests reconsideration of the rejections issued in the above Office Action. Applicant submits that there are persuasive arguments as to why the combination of Carles and other references are deficient in creating a prima facie case of obviousness. Because each of the rejections of the claims relies on Carles, Del Sesto, and Fickinger for disclosing certain limitations in the independent claim, if it can be shown that any one reference is deficient in its teaching with respect to the limitations, then the obviousness rejection cannot be sustained.

Independent Claims 1, 9, and 19

Applicant is focusing on the independent claims, since several limitations, each of which is found in each independent claim, is not addressed or is improperly alleged as being present in

the prior art combination of Carles, Del Sesto, and Fickinger. These comprise four main

arguments, which follow.

1. "a staging server comprising computer readable medium for *storing* an asset"

Carles is alleged to disclose this limitation, as found in column 3, lines 21-28. This text

states:

> stored in a convenient format. Each commercial message is
> a "smart commercial", in that it contains embedded infor-
> mation identifying the categories of recipients for the mes-
> sage. As is explained more fully below, this embedded
> information is utilized by a Commercial Message Manage-
> ment Server (CMMS) 11 to produce a set of subscriber
> addresses corresponding to each category of recipient iden-
> tified by the embedded information.

Thus, the Examiner is analogizing the "smart commercial" as the "asset" of the claim. However,

the limitation recites "a staging server ... **for storing** an asset." It is readily apparent that the

only server disclosed in the cited text is a "Commercial Message Management Server (CMMS)."

However, Carles discloses that the "smart commercials" are stored in the Commercial Messages

Library 38 of FIG. 3, shown below (see, col. 3, line 19-20) which is distinct from the CMMS:
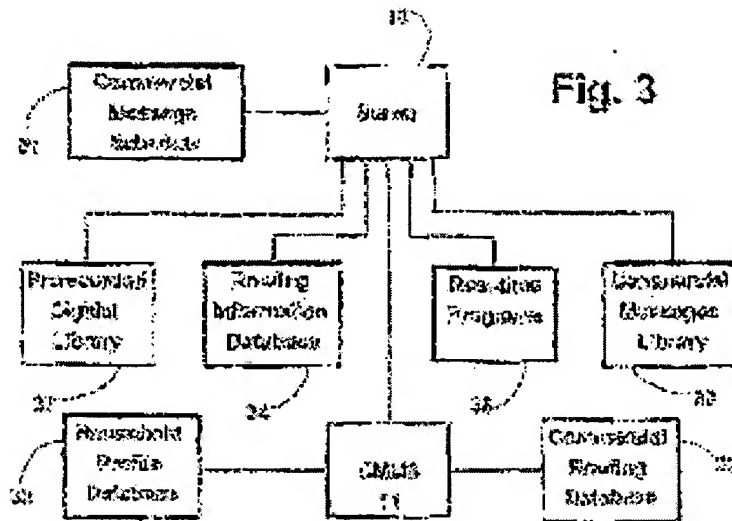
Fig. 3

Carles discloses that the CMMS produces a set of subscriber addresses, but this is not "storing" an asset.

There is one other server discloses in Carles in FIG. 3 which is server 10 that accesses various databases, including a library of "commercial messages 38" (col. 3, line 19) to create an information stream (col. 3, line 1). But again, server 10 retrieves data **already** stored in other databases, and there is no disclosure of using the server 10 or CMMS 11 "for **storing** an asset." While Carles discloses a server 10 for integrating information that is streamed to a user, as shown below; Carles does not disclose the server 10 "for **storing** an asset."
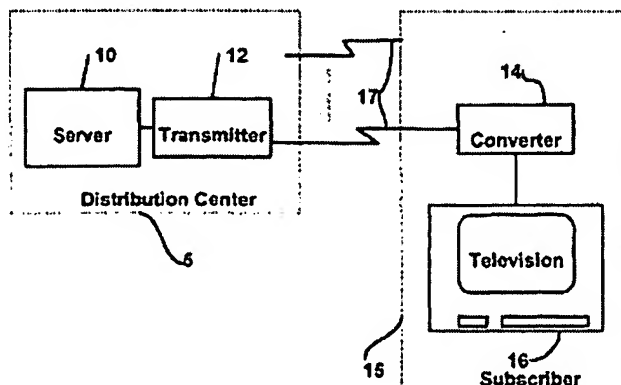
There is no disclosure pointed to in Carles that indicates how the commercial messages are stored into the various "libraries" in Carles. There is no disclosure, teaching or suggestion, nor allegation that the CMMS server 11 or server 10 *stores* an asset in Carles. Because independent claims 1, 9, and 19 are predicated on Carles disclosing this aspect, the prima facie case for obviousness is deficient, and the rejection should be withdrawn.

2. **"an application program identifier identifying an application program executing in a cable headend associated with processing the asset"**

Carles is admitted to not disclose this limitation (OA, p. 3), but rather Flickinger is alleged to teach this limitation. Flickinger is alleged to disclose "a metadata object [that] further comprises an application program identifier identifying an application program (paragraphs 56 and 74)."

Applicant has attempted to elicit further information from the Examiner as to how Flickinger discloses this limitation of an "application program identifier identifying an application program." A previous telephonic interview lead the applicant to believe that clarifying the limitation as a "application <u>program</u> identifier" would distinguish the prior art. Paragraphs 56 and 74 of Flickinger disclose an ad having a "tag" or "vector" embedded within it, and the tag is described as metadata. (Par. 56). However, these paragraphs in Flickinger disclose the "tag or vector can be detected by the STB 200 to determine whether or not to store the ad and when and how to display the ad." (Par. 56).

First, Flickinger clearly discloses the "STB" (Set Top Box) as processing the tag. This does not disclose the limitation "identifying an application program executing **in a cable headend**." Applicant variously amended the independent claims in the prior response to recite "in a cable headend" and this limitation is not shown to be found in Carles, nor is this limitation even addressed in the Office Action. It is quite clear, the set top box and the cable headend are not the same. Applicant submits that independent claims 1, 9, 19 are distinct over the prior art combination as alleged.

Second, there is no disclosure that the "tag" identifies an "application program." The cited text merely states the "tag or ad vector can be used by the STB 2000 to determine whether or not to store the ad (and also when and how to display the ad.") (Par. 74.) This does not disclose identifying "an application program." Merely because the STB uses the tag, that does not mean that the tag itself identifies an application program in the STB for processing the asset.

Because this particular limitation has been the focus of prior interviews, amendments, and Applicant arguments, Applicant requests that the Examiner clearly state the PTO's position as to how this limitation is disclosed in the cited paragraphs if the rejection is not withdrawn. Applicant submits that merely because the STB uses the tag, that does not disclose, nor render obvious, that the tag 'identifies an application program." Further, Applicant notes that claim 9 recites "a **first application program** executing in the cable headend" that processes the "application program identifier to identify a **second application program** executing in the cable headend." It is clearly insufficient to rely on paragraphs 56 and 74 of Flickinger to repeatedly allege disclosure of this limitation where there is no disclosure of more than one application program in Flickinger in these paragraphs, let alone of using the tag to identify the "application program." At most, Flickinger presumes the STB box program "could examine the tag ... and either save it or ignore it based upon the instructions/rules programmed into the STBs 200 ad map." Flickinger discloses the STB is programmed to use the tag value as input to a program in the STB, and there is no disclosure in the cited portion of Flickinger using the tag to identify one of two (or more) application programs in the STB.

Further, without clearly providing in the Office Action further details, Applicant submits the prima facie case of obviousness is deficient. Because independent claims 1, 9, and 19 are predicated on Carles disclosing this aspect, the rejection for these claims based on this allegation should be withdrawn.

3. **"wherein the content object represents data to be stored in one of a plurality of content server in the cable headend."**

Applicant amended claim 9 to recite "identifies the content server from among a plurality of content servers to receive the content from the staging server." Specifically, "from among a plurality of content servers" was added to distinguish the prior art. Similar amendments were added to claims 1 and 19. This limitation is not alleged to be present in Carles, Flickinger, or Del Sol, and the Office Action is completely silent on this limitation.

Because independent claims 1, 9, and 19 each recite this limitation, and the prior art does not disclose this limitation, nor is there any allegation that it is even present in the prior art combination, the prima facie case for obviousness is deficient. Because every limitation in the independent claim has not been shown as present in the prior art, the rejections should be withdrawn.

Further, it is not merely sufficient to show that the prior art discloses a plurality of servers. The limitation in claim 9 recites "a plurality of content servers **to receive the content from the staging server.**" There is no section in the Office Action regarding the rejection of claim 9 that identifies which prior art elements are alleged to be the content server. The Office Action makes clear that "Carles discloses a staging server ..." (OA, p. 2). Regarding the "content server", Flickinger is alleged to disclose "a server" (O.A., p. 3) as well as "Del Sesto teaches a server." (OA, p. 3.) However, there is no clear allegation of which server (Flickinger or Del Sesto) is alleged to receive the content from the staging server. In both instances, the cited text of Flickinger (par. 56 and 74) and from Del Sesto (col. 9, lines 25-50) refer to a set top box ("STB" in Flickinger) or a function located in the set top box ("Broadcast Receiver"). Regardless of which is alleged to be the content server, it is not located in the cable headend (see argument #4 below regarding the limitation ("in the cable headend").

Again, because independent claims 9 recites this limitation, and the prior art does not disclose this limitation, nor is there any allegation that it is even present in the prior art combination, the prima facie case for obviousness is deficient. Because every limitation in the independent claim 9 has not been shown as present in the prior art, the rejection should be withdrawn.

4. **"an application program executing in a cable headend associated with processing the asset"**

The Examiner has admitted that "Carles and Flickinger do not disclose a server with metadata wherein the structure is understood by the application program identified by the application program identifier." Rather, Del Sesto is relied upon for its teaching of "a server with metadata wherein the structure is understood by the application program identified by the application program identifier (col. 9, lines 25-50).

Applicant previously responded in the Response dated December 16, 2008, that the cited portion of Del Sesto for claim 9 (at that time col. 9, lines 34-36 were cited) pertained to the "BR" or Broadcast Receiver in the **set top box.** (Response dated 12-16-2008, page 10-11.) Applicant amended claim 9 in the prior Response to recite "in the cable headend." Similar limitations were added to claim 1 and claim 19. Thus, the claims now variously recite "in the cable headend."

The set top box is not the same as the cable headend, and thus reliance on the teaching of Del Sesto for operation occurring in the set top box does not disclose the claimed limitation in the headend. Further, combining Del Sesto with Carles and Flickinger is inappropriate, since combining a reference regarding the teaching of processing in the set top box would be inapplicable for its teaching of how to perform processing in the headend.

Because independent claims 1, 9, and 19 each recite this limitation, and the prior art does not disclose this limitation as alleged, the prima facie case for obviousness is deficient, and the rejection should be withdrawn.

Summary

Applicant has provided several arguments as to why the combination of Carles, Flickinger, and Del Sesto are deficient for multiple reasons, any of which would show that the prima facia case of obviousness is deficient. Any one of the reasons, if found persuasive, would result in limitations in the independent claims to be distinct over the prior art combination, and would result in the claims being distinct over the prior art. Applicant submits that the dependent claims, which all also rely on Carles, Flickinger, and Del Sesto in combination with another

reference, suffer from the same deficiency, as well. Applicant respectfully requests the rejections to be withdrawn, and the claims be allowed.

CONCLUSION

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefor (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

/Karl H. Koster/

Karl H. Koster
Registration No. 50,684

Customer No. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Tel Atlanta Office (404) 881-7000
Fax Atlanta Office (404) 881-7777

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